

DETAILED ACTION

Claim Objections

1. Claims 5-16 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from any other multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claims 5-16 have not been further treated on the merits.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-4 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a silyl linker for use in solid-phase synthesis comprised of a compound of formula (I) wherein each of R1 and R2 is an alkyl group and (A) is an alkylene group represented by the formula: $-(CH_2)_n-$ wherein "n" is 2-18, does not reasonably provide enablement for any compound of formula (I) as instantly claimed. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims.

There are many factors to be considered when determining whether there is sufficient evidence to support a determination that a disclosure does not satisfy the

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enablement requirement and whether any necessary experimentation is “undue”.

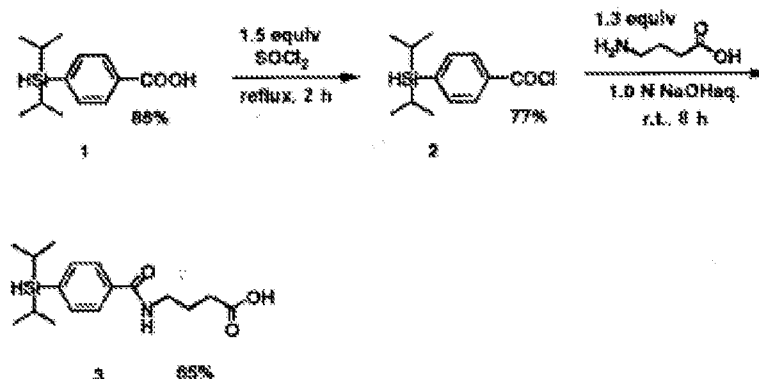
These factors include, but are not limited to:

1. the breadth of the claims;
2. the nature of the invention;
3. the state of the prior art;
4. the level of one of ordinary skill in the art;
5. the level of predictability in the art;
6. the amount of direction provided by the inventor;
7. the existence of working examples; and
8. the quantity of experimentation needed to make or use the invention based on the content of the disclosure.

Claims 1-4 are drawn to a silyl linker for use in solid-phase synthesis comprised of a compound of formula (I).

Undue experimentation is required to determine how to make compounds of formula (I) wherein R1 or R2 is an aryl group or (A) is not an alkylene group represented by the formula: $-(CH_2)_n-$ wherein “n” is 2-18 and to determine which compounds would be useful for solid-phase synthesis. Applicant teaches the following synthetic protocol:

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Applicant does not teach or suggest a synthetic route for obtaining an analogous compound of compound 1 wherein the isopropyl group(s) is replaced by one or more aryl groups nor does applicant teach a non-alkylene group as the spacer moiety.

It is noted that while there are some working examples, it is not seen as sufficient to support the breadth of the claims. The instant specification is not seen to provide adequate guidance which would allow the skilled artisan to extrapolate from the disclosure and examples provided to enable the production of other silyl linkers. It is well established in our law that conception of a chemical compound requires that the inventor be able to define it so as to distinguish it from other materials, and to describe how to obtain it. Functional descriptions of chemical compounds/compositions must be coupled with a known or disclosed correlation between function and structure. An adequate written description of a chemical invention also requires a precise definition such as by structure, formula, chemical name, or physical properties, and not merely a wish or plan for obtaining the chemical invention claimed.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The alkylene group represented by the formula in claim 2 does not permit ether or thioether bonds.

Conclusion

6. Claims 1-16 are pending. Claims 1-4 are rejected. Claims 5-16 are objected to. No claims are allowed.

Contacts

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick T. Lewis whose telephone number is 571-272-0655. The examiner can normally be reached on Monday - Friday 10 am to 3 pm (Maxi Flex).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shaojia A. Jiang can be reached on 571-272-0627. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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/Patrick T. Lewis/
Primary Examiner, Art Unit 1623

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